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SEP 14 2001

OFFICE OF PETITIONS

In re Application of
Luong et al.
Application No. 09/033,965
Filed: March 3, 1998
Attorney Docket No. 24.0787

ON PETITION

This is a decision on the petition filed July 12, 2001, under 37 CFR 1.182 requesting the Office disregard the continued prosecution application and preliminary amendment filed April 24, 2000.

The petition is **dismissed**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. Extensions of time under 37 CFR 1.136(a) are not permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.182." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Facts:

A Notice of Allowance was mailed on March 7, 2001.

On April 24, 2001, a "divisional" CPA and preliminary amendment were filed.

On April 24, 2001, the issue fee (\$1,240) and money for additional copies of the patent (\$30) were submitted.

On July 12, 2001, the instant petition was filed.

On July 16, 2001, a Notice of Allowance for the CPA was mailed.

On August 27, 2001, the issue fee of \$1,240 and \$21 for additional copies were submitted.

Analysis:

The instant petition was not brought before an appropriate deciding official (or even filed) before the request for a CPA was entered. An express abandonment is not effective until it is processed and entered into the file. Therefore, if the appropriate deciding official acts on a petition under 37 CFR 1.182 to disregard a CPA request, it may be granted if the CPA has not been processed or entered. "If the request for a CPA has been entered into the prior application by the time the petition under 37 CFR 1.182 and the application file are before the deciding official for a decision on the petition, the petition will be denied."¹

¹ See Continued Prosecution Application (CPA) Practice; Notice, 1214 Off. Gaz. Pat. Office 32, 32 (September 8, 1998).

Therefore, the instant petition to disregard the request for the CPA cannot be granted.

The prior application is abandoned. Any petition to "set aside" such abandonment (i.e. revive the prior application) must meet the conditions of 35 USC 41(a)(7) and 37 CFR 1.137(b).

The issue fee and fee for copies paid on April 24, 2001, are refundable because one cannot pay an issue fee or fee for additional patent copies for an abandoned application.² Therefore, \$1,270 will be credited to deposit account 19-0610.

Petitioner may wish to file a Request for Continued Examination (\$710 if before October 1, 2001, \$740 if on or after) along with a preliminary amendment containing claims corresponding to the previously allowed claims. In order to file the RCE, petitioner will have to first file a petition to withdraw the application from issue. A petition to withdraw from issue may be filed with the Office of Petitions. If a RCE is filed, rather than a CPA, upon the issuance of a subsequent Notice of Allowance, petitioner may ask in writing that the fees paid on August 27, 2001 be applied towards the fees due and only pay the difference (the Issue fee will be increased to \$1,280 on October 1, 2001).

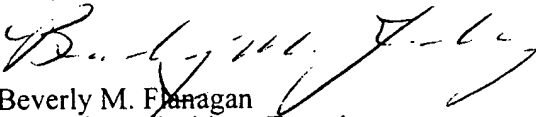
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
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By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
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Crystal Plaza 4, Suite 3C23
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Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.


Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

² The CPA will be deemed to have been entered prior to the issue fee.